

### **REMARKS/ARGUMENTS**

Claims 33, 35-50, 52-59, and 61-81 are pending in this application, with claims 33 and 44 being the only independent claims. Claims 33, 39-46, 48-50, 57-59, and 79-81 are currently amended. Claims 1-32, 34, 51, and 60 were previously canceled. Reconsideration of the above-identified application, as herein amended and in view of the following remarks, is respectfully requested.

Claims 33, 35, 36, 38, 40, 44-50, 52-59, 61-65, 80 and 81 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,656,081 (Isen).

Claims 33, 35, 36, 38, 40, 44-50, 52-59, 61-65, 80 and 81 are rejected under 35 U.S.C. §103(a) as being unpatentable over previously cited U.S. Patent No. 6,147,662 (Grabau) in view of U.S. Patent No. 6,712,931 (Groen).

Claims 37, 39 and 41 are rejected under 35 U.S.C. §103(a) as being unpatentable over Grabau in view of Groen as applied to claims 33, 35, 36, 38, 40, 44-50, 52-59, 61-65, 80 and 81 and further in view of U.S. Patent No. 6,772,709 (Shibata).

Claims 37, 39 and 41 are rejected under 35 U.S.C. §103(a) as being unpatentable over Isen in view of Shibata.

Claims 42-43 are rejected under 35 U.S.C. §103(a) as being unpatentable over Grabau in view of Groen as applied to claims 33, 35, 36, 38, 40, 44-50, 52-59, 61-65, 80 and 81 and further in view of U.S. Patent No. 6,050,189 (Junghans).

Claims 66-79 are rejected under 35 U.S.C. §103(a) as being unpatentable over Grabau in view of Groen as applied to claims 33, 35, 36, 38, 40, 44-50, 52-59, 61-65, 80 and 81 and further in view of U.S. Patent No. 6,246,327 (Eberhardt).

Claims 66-79 are rejected under 35 U.S.C. §103(a) as being unpatentable over Isen in view of Eberhardt.

Independent claim 33

Independent claim 33 is amended to recite "precoating, prevarnishing, or preprinting the printable substrate with varnish or a pre-inking medium that reduces absorbent properties of the printable substrate".

The amendment is made to emphasize that the precoating, prevarnishing, or preprinting is performed on a substrate that is already considered ready to be printed on, i.e., a "printable substrate." This limitation is considered to be required by the previous claim 33, but is now emphasized for the reasons stated below.

Isen does not anticipate independent claim 33 because the substrate disclosed by Isen is Aluminum foil, which can not absorb a paste or ink. Isen discloses applying a dielectric coating 58, which prevents electrical contact with the Aluminum foil (see col. 8, lines 7-9 of Isen). Thus, Isen fails to disclose a varnish or a pre-inking medium that reduces absorbent properties of the substrate and Isen can not be considered to anticipate independent claim 33.

Accordingly, the rejection of claim 33 as anticipated by Isen should now be withdrawn.

Regarding Grabbau in view of Groen, the Office Action acknowledges that Grabbau fails to disclose the above limitations. Groen discloses a method for manufacturing a paper or board web. In other words, Groen relates to the manufacture of a printable substrate. According to Groen, it is known from the prior art

to precoat a paper before the surface-coating proper (see col. 3, lines 50-53 of Groen). Groen further teaches that the most important function of the precoating layer is to reduce the pores present in the surface structure of the base layer to prevent the surface coating layer from being absorbed into the structure (see col. 3, lines 61-66 of Gron). The coating layer itself is used to obtain a smooth surface (see col. 4, lines 7-9 of Gron). Thus, the coating layer and pre-coating layer disclosed by Groen are required to achieve the printable substrate. Moreover, the pre-coating layer and coating layer of Groen, and referred to by the Examiner, are applied before the substrate is considered to be a finished "printable substrate", to achieve a paper with a smooth surface. Since the precoating and coating disclosed by Groen are required to produce a printable substrate, Groen fails to teach anything about applying a further coating on the "printable substrate" for preventing absorption of a conductive ink or paste.

Thus, the combination of Grabbau and Groen fails to teach or suggest "precoating, prevarnishing, or preprinting the printable substrate with varnish or a pre-inking medium that reduces absorbent properties of the printable substrate", as expressly recited in independent claim 33.

Independent claim 44 is amended to include similar limitations and should be allowable for the same reasons as is independent claim 33.

The dependent claims 35-43, 45-50, 52-59, and 61-81 are allowable for the same reasons as are independent claims 33 and 44, as well as for the additional recitations contained therein.

Shibata, Junghans and Eberhardt are not added to show the above limitations, but rather to show additional limitations recited in the dependent claims. Even if they were to show the additional limitations they are purported to show, the additional limitations do not cure the deficiencies discussed above. Accordingly, the pending claims are allowable over the combination of Isen, Grabbau, Groen, Shibata, Junghans, and Eberhardt.

The application is now deemed to be in condition for allowance and notice to that effect is solicited.

Should the Examiner have any comments, questions, suggestions, or objections, the Examiner is respectfully requested to telephone the undersigned in order to resolve any outstanding issues.

It is believed that no additional fees or charges are required at this time in connection with the present application. However, if any additional fees or charges are required at this time, they may be charged to our Patent and Trademark Office Deposit Account No. 03-2412.

Respectfully submitted,  
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